UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,776	12/03/2004	Josef Laumen	112740-1027	5309

29177   7590   01/05/2007

BELL, BOYD & LLOYD, LLC
70 W. MADISON SUITE 3100
CHICAGO, IL 60602

EXAMINER
MATIN, NURUL M

ART UNIT	PAPER NUMBER
2635	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

<table>
<tr><td rowspan="2">

Office Action Summary</td><td>Application No.

10/516,776</td><td>Applicant(s)

LAUMEN ET AL.</td><td></td></tr>
<tr><td>Examiner

Nurul M. Matin</td><td>Art Unit

2635</td><td></td></tr>
</table>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>03 December 2004</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *12-24* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *12-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some *   c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>12/03/2004</u>.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2.   Claim 24 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

According to applicant's detailed specification, one can only ascertain the claimed "computer program product" as nothing more than a carrier wave for transporting multimedia message (MM). Hence, claim 24 is non-statutory. A carrier wave encoded with functional descriptive material (i.e., a computer program product) does not fall within the categories of a process, machine, manufacture, or composition of matter as set forth in 35 USC 101.

Interim Guidelines, Annex IV (c) states:

(c) Electro-Magnetic Signals

Claims that recite nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, per se, and as such are nonstatutory natural phenomena. O'Reilly, 56 U.S. (15 How.) at 112-14. Moreover, **it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in § 101.**

First, a claimed signal is clearly not a "process" under § 101 because it is not a series of steps. The other three § 101 classes of machine, compositions of matter and manufactures "relate

to structural entities and can be grouped as 'product' claims in order to contrast them with process

claims." 1 D. Chisum, Patents § 1.02 (1994).

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4.   **Claim 12-24 is rejected under 35 U.S.C. 102(b) as being anticipated by**

Mostafa, WO 02/43414 (prior art was submitted by applicant in IDS of 12-3-04).

Re claim 12, Mostafa discloses a method for transmitting data in a

communication system (page 1, line 5-7, "In mobile communications networks, the term

Multimedia Messaging Service (MMS) is commonly used to describe a new approach

for transmitting messages having multimedia content"), wherein the data is at least one

of text data and image data with or without sound and includes individual data elements

that are coded to standards which may be different (page 4, line 10-13, "A"stream"can

be, for example, a flow of data typically enabling the recipient to present some

continuous data such as motion pictures (i. e. video), voice or music. In a typical video

stream, some 10 to 20 video frames are transmitted per second"), the method

comprising: performing at least one of a data type and a data format conversion in

accordance with a profile of a receiver of the data; and updating a link, after the

conversion, to maintain a validity of the link in the data between the different data

elements (page 7, line 17-page 8, line 3, "Preferably, the media content comprises a set

of different types of components and each component may be formatted in one or more

formats. Preferably, the method further comprises the following steps before said

providing of the media content: checking the format of at least one component of the

received media content; determining by using the recipient data whether the format is

appropriate for said at least one addressed recipient; and if necessary, translating the

component into a format appropriate for said at least one addressed recipient.

Advantageously, the media content is translated if necessary into an appropriate format,

so that typically no regeneration or conversion of the media content is required at the

sending entity. Thus, retransmission of the content from the sending entity can also be

avoided. This feature has the advantage of saving data transmission resources in the

communication system, as the media content need not be retransmitted and received

again at said network entity"). See also page 20, Para 2.

Re claim 13, A method for transmitting data in a communication system as

claimed in claim 12, wherein the conversion is performed at a provider of the receiver

(page 7, line 30-page 8, line 5, "Advantageously, the media content is translated if

necessary into an appropriate format, so that typically no regeneration or conversion of

the media content is required at the sending entity. Thus, retransmission of the content

from the sending entity can also be avoided").

Re claim 14, A method for transmitting data in a communication system as

claimed in claim 12, further comprising verifying the link in the data between different

data elements (page 13, line 1-8, "accessing a database comprising recipient data

describing multimedia reception capabilities and/or reception preferences for the at least

one addressed recipient; notification means for forming, in accordance with said

recipient data, a notification message containing information that said media content is

available to be streamed to said at least one addressed recipient; and outputting means

for outputting the notification message for transmission to said at least one addressed

recipient").

Re claim 15, A method for transmitting data in a communication system as

claimed in claim 12, further comprising preparing the data for transmission as a plurality

of data packets containing a header to transport organization information and a body to

transmit appropriate payload information as the data elements (page 18, line 22-page

19, line 3, "Since the media content contained in a particular multimedia message is

stored in MMS server B and the storing operation is performed via MMS relay B, MMS

relay B has access to information describing the media content which, for example, was

encapsulated with the multimedia message sent from MMS user agent A. MMS relay B

is also aware of the properties and behavior of MMSE B as, according to currently

agreed recommendations covering the implementation of the multimedia messaging

service in 3rd generation networks, MMS relay B is considered to be the control point

for MMSE B. This also means that MMS relay B has access to information describing

the configuration and capabilities of MMS user Agent B, which, as described in

connection with Figure 1, is stored in a database linked to the relay. MMS relay B is

further aware of its own capabilities to convert between different media types and/or
formats.

Re claim 16, A method for transmitting data in a communication system as
claimed in claim 12, wherein the data is transmitted as a multimedia message in a
Multimedia Messaging Service (page 16, line 29-30, " when initiating the communication
of a multimedia message to MMS (multimedia messaging service) user agent B, MMS
user agent A first selects the media content to be transmitted").

Re claim 17, A method for transmitting data in a communication system as
claimed in claim 16, wherein the data is transmitted on a WAP-enabled mobile phone
(page 2, line 12-22, "The MMS relay is also shown to be linked with two mobile
telecommunication networks. The different telecommunication networks may, for
example, have different operators, different geographical locations or coverage areas
and/or differ in terms of their technical characteristics. For example, they may belong to
different technical generations such as **GSM and UMTS** (WAP-capable mobile
phone)").

Re claim 18-23, which claim the same subject matter as recited in claim 12-17.
Therefore, claim 18-23 has been analyzed and rejected with respect to claim 12-17.

Re claim 24, A computer program product having a computer-readable storage
medium on which a program is stored which, upon loading on in a memory of a
computer, enables the computer, as part of a data transmission in a communication
system, to receive data from a subscriber of the communication system (page 13, line

25-page15, line 9, " wherein the data is at least one of text data and image data with or

without sound and includes individual data elements that are coded to standards which

may be different, to perform at least one of a data type and a data format conversion in

accordance with a profile of a further subscriber of the communication system to receive

the data, and to update a link, after the conversion, to maintain a validity of the link in

the data between different data elements prior to the data being sent to the further

subscriber(page 13, line 25-page15, line 9, "According to a fourth aspect of the

invention, a computer program is provided for controlling a network entity, comprising:

computer code for causing the network entity to receive media content from a sending

entity and addressed to at least one recipient; computer code for causing the network

entity to access a database comprising recipient data describing multimedia reception

capabilities and/or reception preferences for the at least one addressed recipient;

computer code for causing the network entity to form, in accordance with said recipient

data, a notification message containing information that said media content is available

to be streamed to said at least one addressed recipient; and computer code for causing

the network entity to output the notification message for transmission to said at least
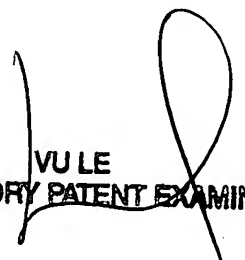
one addressed recipient").

Conclusion

5.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Nurul M. Matin whose telephone number is 571-270-

1188. The examiner can normally be reached on mon-fri (7:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vu Le can be reached on 571-272-7332. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nurul Matin

VU LE
SUPERVISORY PATENT EXAMINER